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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 09/886,256 | 06/22/2001 | Masaaki Mawatari | 210241US0 | 5541 |
| 22850 | 7590 | 10/23/2003 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. | | | WOODWARD, ANA LUCRECIA | |
| 1940 DUKE STREET | | | ART UNIT | PAPER NUMBER |
| ALEXANDRIA, VA 22314 | | | 1711 | |

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 7/28/2003

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) 18 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 18 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The end-capped polyamides required by new claim 18 are patentably distinct species from the originally presented non-capped polyamides. If both species had been originally presented, an election of species requirement would have been applicable under 35 U.S.C. 121 to elect a single disclosed species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. Claims 8-12, 14-16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 8, it is unclear how the recitation of other diamines limits the recitation of tetramethylenediamine per the base claim.

In claims 10 and 12, it is unclear how the recitation of other dicarboxylic acids limits the recitation of adipic acid per the base claim.

In claims 9, 11, 15 and 15, it is unclear what the amounts are based upon.

In claim 14, no express antecedent basis is seen for "said diamines other than..."

In claim 19, the term "obtainable" is indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,143,983 (Yamagishi et al) as per reasons of record.

Response to Amendment

5. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive.

Applicants' contention that the examiner has acknowledged that "Yamagishi et al fail to disclose or suggest a semi-aromatic polyamide including at least one of 1,9-nonanediamine and 2-methyl-1,8-octane diamine" is incorrect. Attention is directed to page 3 of the previous Official action wherein it is stated that "Yamagishi et al differs from the presently claimed invention *in not expressly exemplifying* a semi-aromatic polyamide composed of at least one of

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1,9-nonanediamine and 2-methyl-1-1,8-octanediamine with terephthalic acid” (with emphasis).

The general disclosure of Yamagishi et al clearly embraces polyamides derived from terephthalic acid (the preferred dicarboxylic acid) and aliphatic diamines having 9 carbon atoms (column 3, lines 34-35). Accordingly, it would have been obvious to one having ordinary skill in the art to have used a polyamide meeting the terms of applicants’ component B with the reasonable expectation of success, absent evidence of unusual or unexpected results.

6. In response to applicant's argument that Yamagishi et al is not aimed at solving the problem of blistering of polyamide 4,6, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Ohiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. With respect to Examples 1-7 proffered by applicants as evidence of unusual or unexpected results, only examples 1-3 and comparative examples 1 and 2 can be directly compared, in terms of fixed variables. A comparison of said five examples, however, fails to establish any usual or unexpected results for using the polyamide B). From the data presented, it would appear that polyamide B (comparative example 2 with 99% polyamide B) is inherently governed by improved blister resistance as compared to polyamide A (comparative example 1 contains 99% polyamide A). Thus, it would follow that compositions comprising a combination of polyamide A and significant amounts of polyamide B (examples 1-3) would have improved blister resistance, as compared to compositions containing a combination of polyamide A but only minute amounts of polyamide B (comparative example 1). It is noted that the present claims embrace as little as 5% by weight of polyamide B, whereas inventive examples 1-3

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provided are directed to much higher amounts of polyamide B. As to the other molding properties listed, no pattern of superiority or unexpected results is seen for inventive examples 1-

8. Applicants' newly added claims do not appear to patentably distinguish the presently claimed subject matter. In this regard, attention is directed to column 3, lines 27-33, column 4, lines 28-39, column 6, lines 1-5, etc. for the disclosure of further incorporation of additional components, such as lactams, fillers and other conventional adjuvants as the case requires. The disclosure of the reference, by being silent to the relative viscosities of its components, implicitly suggests and embraces the viscosities preferred by applicants.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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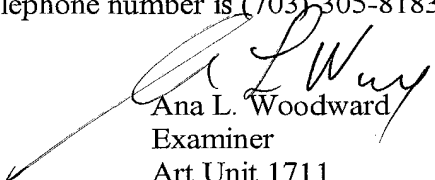
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (703) 308-2401.

The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8183.



Ana L. Woodward
Examiner
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